

**REMARKS/ARGUMENTS**

In the Office Action mailed October 4, 2005, claims 1-8 stand rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable.

Claims 1, 2, 5 and 8 are presently amended. No claims are cancelled. No claims are added. As such, claims 1-8 remain pending.

**CLAIM REJECTION – 35 U.S.C. § 112, second paragraph**

Claims 1-8 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. On page 3 of the Office Action, the Examiner makes specific suggestions to cure the rejection by amendments to claims 1, 2, 5, and 8. Applicants have considered the Examiner's suggestions and have amended the claims as suggested to remove ambiguities and make the claims clearer and more definite, in exact accordance with Examiner's suggestions. In the claims set forth at the beginning of this paper, all amendments have been shown in accordance with practice required for amendments to claims in reissue applications, as per 37 CFR § 1.173(c). For convenience, the present Claim 8 is shown below with elements deleted herein as shown by strikethrough characters:

8. **(Currently Amended)** A convertible rongeur comprising a front handle piece;  
a bottom shaft piece moveably attached to said front handle piece, said bottom shaft piece having a tip shaft portion and a handle portion and a longitudinal axis from said handle portion to said tip along said shaft portion, said front handle piece being compressed toward said handle portion of said bottom shaft piece to operate said rongeur; and  
a top shaft cutting piece slideably engaged along said longitudinal axis, with said tip shaft portion of said bottom shaft piece, wherein said top shaft cutting piece is disengageable from said bottom shaft piece such that the top shaft cutting piece no longer touches said bottom shaft piece but remains linked to the remainder of said rongeur.

Applicants therefore respectfully assert that no new matter has been added to the patent for which reissue is sought, as all elements recited in claims 1, 2, 5 and 8, as amended, are properly disclosed in the original patent. Applicants accordingly respectfully request that the rejection with respect to 35 U.S.C. § 112, second paragraph be withdrawn. At the least, Claims 1-7 are therefore believed allowable, as so stated on page 4 of the Office Action, since they have been amended to overcome the rejections under 35 U.S.C. § 112, second paragraph set forth in the Office Action.

#### **CLAIM REJECTION – 35 U.S.C. § 102(b)**

Claim 8 is rejected under 35 U.S.C. 102(b), as anticipated by or, in the alternative, under 35 U.S.C. 103(a), as obvious over German Patent 9421145.6 to Wolf (Wolf). The Office Action states on page 4 that Wolf discloses “a convertible rongeur comprising front handle piece 1.2, bottom shaft piece 2, 1.1 having shaft portion 2 and handle portion 1.1, top shaft cutting piece 5 slideably engaged along said longitudinal axis with the shaft portion 2, the top shaft cutting piece

5 being disengageable with the shaft portion 2 such that the top shaft cutting piece no longer touches the bottom shaft piece (when the top shaft cutting piece 5 is pivoted to the position shown in dashed lines in figure 1) but remains linked to the remainder of rongeur (since it is still linked to movable jaw part 3.2 as indicated on page 5, lines 1-2 of the translation). Alternatively, it would have been obvious that the top shaft piece 5 is a “cutting” piece as claimed since it, in combination with the movable jaw part 3.2, performs the cutting action.”

However, Applicants respectfully assert that the top shaft cutting piece 5 in Wolf, when disengaged from the shaft portion 2, does not remain attached and so “linked to the remainder” of the rongeur as claimed in Claim 8, but, rather, is fully detachable and removed from the rest of the “forceps” in Wolf. This is clearly stated on lines 1-4 on page 6 of Wolf: “by pivoting the rod 5 about the pin 3.5, the rod 5 can be brought into a position according to Fig. 1 and can then be separated from the forceps by withdrawing the distal forked end of the rod from pin 3.5.” Therefore, the rod 5 in Wolf is arranged to be completely removed from the rest of the tool, rather than remain linked thereto. This is further emphasized on lines 14-24, page 6 of Wolf, whereby the procedure for “assembling the forceps” is described. This is accomplished by inserting the distal end of the rod 5 into pin 3.5 proximate the forceps jaw portion.

Thus, the invention recited in Claim 8 is novel and non-obvious with respect to the forceps disclosed in Wolf, as is it structurally and functionally different in many ways.

First, the rongeur recited in Claim 8 includes a “cutting piece” which is missing in the forceps of Wolf. This is due to the fact that the tool disclosed in Wolf, being a forceps for gripping, is functionally different from the tool recited in Claim 8, which is a rongeur that is primarily used to excise tissue, and not merely to grip it. The Office Action states that “it would have been obvious that the top shaft piece 5 is a ‘cutting’ piece as claimed since it, in

combination with the movable jaw part 3.2, performs the cutting action.” Applicants respectfully disagree and assert that the movable jaw in Wolf does not perform a cutting action. A forceps as shown in Wolf is not a cutting instrument.

Furthermore there is no indication in the specification of Wolf that the disclosed tool is a cutting instrument, or that the movable jaw portion 3 therein can perform cutting actions. This can be further deduced by close inspection of the structure of the jaw portion 3 in Wolf, whereby the movable jaw part 3.2 is actuated by the force of the distal end portion of rod 5 applied against pin 3.5 about the pivoting axis 3.4. (See Wolf: page 4, line 30 to page 5, line 6). Because of the small distance between the pivot point 3.4 and force application point 3.5, the relative moment that can be applied to movable jaw part 3.2 by actuation of rod 5 is too small to transfer a force high enough to provide cutting action. For this reason alone, Applicants respectfully assert that the invention as recited in Claim 8 is novel and non-obvious over Wolf.

Another critical difference between the devices of the subject invention and that disclosed in Wolf is that the rongeur recited in Claim 8 has a top shaft piece which is disengageable from the rest of the rongeur, but which remains linked to it. This critical feature is inventive subject matter which overcomes the shortcomings in the prior art discussed in the specification, namely, that when prior art “rongeurs are disassembled the instrument is in a number of parts...which can be easily lost or misplaced during the process.” (Specification as recited in US Patent No. 5,961,531, col. 2, lines 19-22). As discussed above, the forceps in Wolf, when disassembled, results in multiple separate parts. Accordingly, the features disclosed in Wolf do not overcome the shortcomings of the prior art specifically contemplated and overcome by the Applicants. By contrast, the features recited in Claim 8, as amended, accomplish one of the objects of the present invention, namely, to provide “an instrument that stays together in one piece, thereby

avoiding loose parts that can be lost.” (Specification as recited in US Patent No. 5,961,531, col. 2, lines 45-46). Applicants respectfully assert that this feature is accomplished by the present invention as recited in Claim 8, which invention is certainly novel over Wolf, in light of the fact that Wolf does not teach every element recited in Claim 8, such as, specifically, a top shaft piece which is disengageable from the rongeur but remains linked to the remainder of said rongeur.

Furthermore, the feature of a top shaft piece which is disengageable from the rongeur but remains linked to the remainder of said rongeur, as recited in Claim 8, is non-obvious over Wolf, as there is no motivation or suggestion in Wolf to provide for such a feature. Furthermore, such a feature involves more than a routine design choice but instead involves a complex structural and functional element that incorporates inventive subject matter created to overcome specific shortcomings in the prior art. Wolf, by disclosing an instrument which is disassembled into multiple parts, instead teaches away from the invention recited in Claim 8. As such, Applicants respectfully assert that Claim 8, as amended, is non-obvious over Wolf.

Accordingly, for the reasons set forth above, Claim 8, as amended, is believed to be allowable over Wolf. Applicants therefore respectfully request that the rejection with regard to 35 U.S.C. 102(b), or, in the alternative, under 35 U.S.C. 103(a), be withdrawn.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Docket No. 59474.21501  
Application No. 09/627,018  
Customer No. 30734

Patent

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21501.

Respectfully submitted,

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